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10/006,530	12/05/2001	Naoto Akimoto	1232-4792	1342

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EXAMINER

MENBERU, BENIYAM

ART UNIT PAPER NUMBER

2625

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/006,530	Applicant(s) AKIMOTO ET AL.	
	Examiner Beniyam Menberu	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, see Remark, filed September 11, 2006, with respect to the rejection(s) of claim(s) 1, 16, and 18 under U.S. Patent No. 6356356 to Miller, Jr. et al further in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 6157706 to Rachelson.

2. Applicant's arguments, see Remark, filed September 11, 2006, with respect to the rejection(s) of claim(s) 10, 17, and 19 under U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6658456 to Shimoosawa have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 6157706 to Rachelson.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 18 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 18 and 19 recite "A storage medium storing a program". Claims 18 and 19 should read "A computer readable medium storing a computer program".

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 10, 16, 17, 18, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 10, 16, 17, 18, and 19 recite the limitation of registration of electronic mail and format upon receiving a request from the client but the specification does not disclose of "receiving a request from the client" for the purpose of registration of electronic mail account and format.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 7, 8, 10, 13, 16, 17, 18, 19 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent

Application Publication Pub. No. US 2002/0075524 A1 to Blair et al.

Regarding claims 1, 16, and 18, Rachelson discloses a communication apparatus comprising:

registration means for registering an electronic mail account of a client via a first network upon receiving a request from the client, wherein the request includes a customized format of an image to be received (column 8, lines 3-15; column 10, lines 21-31; column 11, lines 21-29; Figure 2, the administrator 100 communicates over internet);

reception means for receiving data, from a second network that uses a different communication protocol from the first network (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 and the EPO is connected to an internet; EPO receives fax data from 103 as shown in Figure 2;);

confirming means for confirming whether the client maintains a valid account (column 11, lines 12-18; column 8, lines 21-27);

generating means for generating an electronic mail directed to the client's account based on the received data at said reception means as well as the client's customized format received at said registration means (column 11, lines 21-29);

and

transmission means for transmitting the electronic mail generated by said generating means to the client's electronic mail account (column 11, lines 30-28). However Rachelson does not disclose wherein data includes color image information and/or monochrome image information

Blair et al discloses receiving color image information (page 5, paragraph 48, page 6-7, paragraph 64).

Rachelson and Blair et al are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the color image transmission of Blair et al with the system of Rachelson to implement color image forwarding through e-mail.

The motivation to combine the reference is clear because if a receiver is capable of printing color images then it would be convenient for the receiver to receive color images through e-mail.

Regarding claims 10, 17, and 19, Rachelson discloses a communication apparatus comprising:

registration means for registering electronic mail accounts of a plurality of clients via a first network upon receiving requests from each of the plurality of clients, wherein each of the requests includes a customized format of an image to be received (column 8, lines 3-15; column 10, lines 21-31; column 11, lines 21-29; Figure 2, the administrator 100 communicates over internet; column 2, lines 43-48; column 8, lines 15-28);

reception means for receiving data, from a second network that uses a different communication protocol from the first network (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 and the EPO is connected to an internet; EPO receives fax data from 103 as shown in Figure 2);

management means for validating the registered electronic mail accounts (column 11, lines 12-18; column 8, lines 21-27) and generating electronic mails for the validated electronic mail accounts based on the data received by said reception means as well as each clients' customized format received by said registration means (column 11, lines 21-29; column 8, lines 26-27; column 2, lines 33-42); and

transmission means for transmitting the generated electronic mails to each of the clients' electronic accounts validated by said management means (column 11, lines 30-28; column 8, lines 26-27; column 2, lines 33-42). However Rachelson does not disclose data which includes color image information and/or monochrome image information.

Blair et al discloses receiving color image information (page 5, paragraph 48, page 6-7, paragraph 64).

Rachelson and Blair et al are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the color image transmission of Blair et al with the system of Rachelson to implement color image forwarding through e-mail.

The motivation to combine the reference is clear because if a receiver is capable of printing color images then it would be convenient for the receiver to receive color images through e-mail.

Regarding claim 2, Rachelson in view of Blair et al teach all the limitations of claim 1. Further Rachelson discloses the communication apparatus according to claim 1, wherein said generating means attaches an image received by said reception means to the electronic mail (column 11, lines 21-29; column 10, lines 40-49).

Regarding claim 7, Rachelson in view of Blair et al teach all the limitations of claim 1. Further Rachelson discloses the communication apparatus according to claim 1, wherein the customized format of an image includes information on an encoding system of said attached image (column 11, lines 25-29).

Regarding claim 8, Rachelson in view of Blair et al teach all the limitations of claim 1. Further Blair et al discloses the communication apparatus according to claim 1, wherein said reception means receives the color and/or monochrome image information based on a facsimile procedure (page 5, paragraph 48, page 6-7, paragraph 64; page 4, paragraph 30, lines 5-7).

Regarding claim 13, Rachelson in view of Blair et al teach all the limitations of claim 10. Further Rachelson discloses the communication apparatus according to claim 10, wherein said management means is capable of managing a plurality of electronic mail accounts registered at said registration means (column 8, lines 15-28; Figure 9a).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6658456 to Shimoosawa.

Regarding claim 5, Rachelson in view of Blair et al teach all the limitations of claim 1. However Rachelson in view of Blair et al does not disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether or not to attach the image to the electronic mail.

Shimoosawa discloses the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether or not to attach the image to the electronic mail (column 5, lines 13-20).

Rachelson, Blair et al, and Shimoosawa are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the registration system of Shimoosawa with the system of

Rachelson in view of Blair et al to implement registration of email address for forwarding data.

The motivation to combine the reference is clear because by registering email address will make forwarding of received data quicker.

Regarding claim 12, Rachelson in view of Blair et al teach all the limitations of claim 10. Further Shimoosawa discloses the communication apparatus according to claim 10, wherein said management means manages whether to transmit only text (column 8, lines 50-61), transmit only attachment file (column 10, lines 55-67) or transmit both the text and the attachment file of the received data (column 9, lines 62-67; column 10, lines 1-16).

Regarding claim 14, Rachelson in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 10. Further Shimoosawa disclose the communication apparatus according to claim 10, wherein said management means manages whether or not one of the registered email accounts is a mobile terminal (Shimoosawa discloses that mobile PDA can be used as recipient of email data (column 1, lines 24-29; column 8, lines 48-55; column 9, lines 1-13)).

Regarding claim 15, Rachelson in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 14. Further Shimoosawa disclose the communication apparatus according to claim 14, wherein said management means manages the setting in case of forwarding an electronic mail to the mobile terminal (Shimoosawa teaches that when transferring data to mobiles like PDA, the attachments

can be excluded from the data sent to prevent the PDAs from becoming memory full (column 8, lines 48-67).).

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6721783 to Blossman et al.

Regarding claim 6, Rachelson in view of Blair et al teach all the limitations of claim 1. However Rachelson in view of Blair et al does not disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether to attach all or a part of said received image.

Blossman et al disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether to attach all or a part of said received image (Blossman et al disclose method of sending bank customers images of bank related documents through email based on customer preference on which documents to be sent (column 16, lines 1-5, lines 23-33, lines 45-54).).

Rachelson, Blair et al, and Blossman et al are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the selective email transmission system of Blossman et al with the system of Rachelson in view of Blair et al to implement destination specific transmission of image data.

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The motivation to combine the reference is clear because the teaching of Blossman et al can implement a destination specific transmission of important documents based on preference of users (column 4, lines 38-41).

12. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6883016 to Fujii et al.

Regarding claims 9 and 11, Rachelson in view of Blair et al teaches all the limitations of claim 8 and 10 respectively. However Rachelson in view of Blair et al does not disclose the communication apparatus according to claim 8, wherein said facsimile procedure is based on the ITU-T T. 37 recommendation.

Fujii et al disclose facsimile procedure based on the ITU-T T. 37 recommendation (column 1, lines 15-24).

Rachelson, Blair et al, and Fujii et al are combinable because they are in the similar problem area of email transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ITU-T T.37 standards of Fujii et al with the system of Rachelson in view of Blair et al.

The motivation to combine the reference is clear because Fujii et al teaches that image transmission through email is done using ITU-T T.37 standard (column 1, lines 20-23).

Other Prior Art Cited

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6707580 to Bloomfield discloses system for facsimile/E-mail communication.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.


For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

11/27/2006


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER